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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,553	03/18/2002	David Lawrence Coombs	15704-1US	4961

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EXAMINER	
BRAGDON, REGINALD GLENWOOD	
ART UNIT	**PAPER NUMBER**
2188	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/098,553	COOMBS, DAVID LAWRENCE	
	Examiner	Art Unit	
	Reginald G. Bragdon	2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 July 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The IDS filed 05 July 2002 has been considered except as note below.

2. Non-patent documents "Net Integrator Backup System Technical Overview" and "Newly Launched: Mark I-idb and Mark II-idb" have not been considered since they do not include the date of publication (including at least the month and year) as required 37 CFR 1.98(b)(5) and MPEP 609.

Drawings

3. The drawings filed on 18 March 2002 have been approved by the Examiner.

Specification

4. The disclosure is objected to because of the following informalities:

In paragraph [0019] on page 5, "Figs. 3 and 4" should be --Figs. 3A, 3B, and 4--.

In paragraph [0045] (on page 17, line 3), "lest" should be --least--.

In paragraph [0055] (on page 21, line 8), "change" should be --changed--.

Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

In claim 20, Applicant sets forth a "computer readable medium containing executable program instructions". However, a computer readable medium containing executable program instructions has not been set forth in the body of the specification.

35 U.S.C. 112, Sixth Paragraph

6. In claim 11, line 2, Applicant sets forth "a processing means". However this is not the proper format for a "means plus function" limitation under 35 U.S.C. 112, sixth paragraph, which must be expressed as a "means for" (e.g. "means for processing"). This limitation will be interpreted as a "processor".

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-9, 11-18, and 20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8, 10, 16-23, and 28 of copending Application No. 10/390,038. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 1 of the present application corresponds to claim 1 of the '038 application.

Claim 2 of the present application corresponds to claim 2 of the '038 application.

Claim 3 of the present application corresponds to claim 3 of the '038 application.

Claim 4 of the present application corresponds to claim 4 of the '038 application.

Claim 5 of the present application corresponds to claim 5 of the '038 application.

Claim 6 of the present application corresponds to claim 6 of the '038 application.

Claim 7 of the present application corresponds to claim 7 of the '038 application.

Claim 8 of the present application corresponds to claim 8 of the '038 application.

Claim 9 of the present application corresponds to claim 10 of the '038 application.

Claim 11 of the present application corresponds to claim 16 of the '038 application.

Claim 12 of the present application corresponds to claim 17 of the '038 application.

Claim 13 of the present application corresponds to claim 18 of the '038 application.

Claim 14 of the present application corresponds to claim 19 of the '038 application.

Claim 15 of the present application corresponds to claim 20 of the '038 application.

Claim 16 of the present application corresponds to claim 21 of the '038 application.

Claim 17 of the present application corresponds to claim 22 of the '038 application.

Claim 18 of the present application corresponds to claim 23 of the '038 application.

Claim 20 of the present application corresponds to claim 28 of the '038 application.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 10 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 26 of copending Application No. 10/390,038

Claims 14 and 26 of Application No. 10/390,038 contain every element of claims 10 and 19 of the instant application and as such anticipates claims 10 and 19 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-5 and 7-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (5,813,009).

Claim interpretation note: Claims 1, 11 and 20 set forth storing a full backup. The claims also set forth storing zero, one or more incremental backups (emphasis added). Since Applicant has set forth that zero incremental backups may be performed, then the limitation of "storing...incremental backups" is not necessary. Furthermore, if there are zero incremental backups, then "storing parent data representative of the relationship of each incremental backup to its respective parent backup" is also not necessary (since there are no incremental backups to provide a relationship representation). Therefore, a reference which teaches only "storing to a backup storage device coupled to the computer system at least one full backup, each full backup comprising a copy of said data selected from the first storage device in accordance with first criteria and attribute data representative of attributes of the selected data" would meet the claim limitations of the independent claims.

Furthermore, claims 2-5, 7-10, and 12-19, are also not necessary in that they set forth limitations that are not performed if there are zero incremental backups.

As per claims 1, 11, and 20, Johnson teaches a full backup system for the database, stored image, and electronic files ("storing to a backup storage device coupled to the computer system

at least one full backup"). See column 28, lines 15-21. The system allows authorized users to set the date, time, and frequency of the database backup ("in accordance with a first criteria"). See column 30, lines 44-47. The claimed "attribute" of the data is that the data is database data. See column 28, line 16, and column 30, line 45. It is noted that there are zero incremental backups set forth, and therefore steps b) and c) are not performed (and as set forth above, not required). A similar rationale exists for claims 2-5, 7-10, and 12-19.

13. Claims 1-2, 5, 11-12, 15, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Saxon (5,758,359).

As per claims 1, 11, and 20, Saxon teaches a data backup system with a processor 22 and storage devices 14, the processor coupled through bus 16 to the storage devices (primary, secondary, and backup). For all backups, ascertaining which files are eligible for backup comprises examining the associated file attributes ("*attribute data representative of attributes of the selected data*"). The "first criteria" is the selection of time to perform backups, which Saxon teaches by a backup scheduler (column 4, lines 16-17) and scheduling backups for particular time periods (column 9, lines 19-28). The "second criteria" is the selection of files to backup which have been modified since the most previous backup (column 5, lines 39-47), thus creating an incremental backup. Full backups (which would use the attributes and the first criteria) are performed once per quarter (column 9, lines 20-21). Multiple incremental backups are performed on weekly and daily schedules (column 9, lines 21-28). A master catalog 36 maintains information concerning the backups, including the file chronology ("*relationship of each incremental backup to its respective parent backup in a dependency data structure*"). See column 4, lines 39-64.

As per claims 2 and 12, Saxon teaches performing incremental backups at weekly and daily times ("*two or more time intervals*"). See column 9, lines 21-28.

As per claims 5 and 15, Saxon teaches storing the master catalog information in a tree structure. See column 4, lines 60-62.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. or Saxon in view of Franklin (6,061,770).

As per claim 6, Johnson et al. or Saxon does not teach verifying the full backup. Franklin teaches verifying a complete (i.e. full) backup. See column 1, lines 26-30. It would have been obvious to one of ordinary skill in the art to have modified Johnson et al. or Saxon to verify a full backup, as suggested by Franklin, because Franklin teaches that verifying the backup would ensure that files are correctly backed-up (see column 1, lines 26-30), thereby reducing problems in the system.

16. Claims 7-9 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxon in view of Hubbard (2002/0013832).

Saxon does not teach automatically paring a backup file when space is needed. Hubbard teaches, in paragraph [212] on page 25, deleting older backup files when new files exist, using an

automatic storage management scheme (paragraph [208]). It would have been obvious to one of ordinary skill in the art to have modified Saxon to have deleted older backup files when space was needed, as suggested by Hubbard, because this would provide storage area on the device when space was running low, improving the operating efficiency. See paragraph 208.

Conclusion

17. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

All "OFFICIAL" patent application related correspondence transmitted by FAX must be directed to the central FAX number at **(703) 872-9306**:

"INFORMAL" or "DRAFT" FAX communications may be sent to the Examiner at **(703) 746-5693** (after October 14, 2004, the "INFORMAL" or "DRAFT" FAX number will be 571-273-4204), only after approval by the Examiner.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (receptionist).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reginald G. Bragdon whose telephone number is (703) 305-3823 (after October 14, 2004, the telephone number will be 571-272-4204). The examiner can normally be reached on Monday-Thursday from 7:00 AM to 4:30 PM and every other Friday from 7:00 AM to 3:30 PM.

The examiner's supervisor, Mano Padmanabhan, can be reached at (703) 306-2903 (after October 14, 2004, the telephone number will be 571-272-4210).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Reginald G. Bragdon
Primary Patent Examiner
Art Unit 2188

RGB
September 16, 2004